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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,008	12/08/2003	Fumiaki Itoh	03560.003431.	9138
5514 7590 06/30/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
SERRAO, RANDI H N				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/729,008

Applicant(s)

ITO ET AL.

Examiner

RANODHI N. SERRAO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.
2. The applicant argued in substance the newly added limitations of independent claims 1, 5, and 9 and the newly added claims 14-16. However, the new grounds teach these and the added features. See rejections below.

Claim Objections

3. Claims 1 and 5 are objected to because of the following informalities: Claim 1 recites, "the transmission source device, which device is connected to the network" in lines 4 and 5. This is grammatically incorrect and should read "the transmission source device, which is connected to the network." Claim 5 recites similar limitations and is objected under the same rationale. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1, 5, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

6. Claim 1 recites the phrase, "in a case..." in lines 11 and 16. The examiner points out that "in a case" is a conditional statement. Therefore the limitations following these statements do not necessarily have to be given any weight within the claim. For instance, there is no step that follows if the network address is not within the address range and has been generated from the obtained local address unique to the transmission source device. In this situation, none of the recited conditions would take effect and thus would invalidate these limitations. These limitations would also be irrelevant with any other situation that does not fall under these two conditional statements. Claims 5 and 9 recite similar limitations and are rejected under the same rationale.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
8. Claims 1 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawada et al. (2002/0016858) and Ala-Laurila et al. (6,704,789).
9. As per claim 1, Sawada et al. teaches an address restriction method executed by an address restriction apparatus on a network, comprising the steps of: obtaining, from a message received from a transmission source device, a tentative network address generated by the transmission source device, which device is connected to the network, and a local address unique to the transmission source device (see Sawada et al., ¶ 75-76); determining whether the obtained tentative network address is a network address

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which is within an address range determined according to a predetermined rule (see Sawada et al., ¶ 255) and has been generated from the obtained local address unique to the transmission source device (see Sawada et al., ¶ 259); and in a case where the determining step determines that the tentative network address is the network address which is within the address range determined according to the predetermined rule and has been generated from the obtained local address unique to the transmission source device, permitting the transmission source to use the tentative network address for performing communication on the network (see Sawada et al., ¶ 242); and in a case where the determining step determines that the tentative network address is the network address which is within the address range determined according to the predetermined rule but has not been generated from the obtained local address unique to the transmission source device, discarding the packet (see Sawada et al., ¶ 242-243). But fails to teach sending a message to the transmission source device forbidding the use of the obtained tentative network address. However, Ala-Laurila et al. teaches sending a message to the transmission source device forbidding the use of the obtained tentative network address (see Ala-Laurila et al., col. 1, line 66-col. 2, line 23). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Sawada et al. to sending a message to the transmission source device forbidding the use of the obtained tentative network address in order to enable a user to utilize a single mechanism for the dual functions of obtaining an IP address in a data network, which preferably is a packet data network or a wireless LAN network and

authenticating in the network providing connectivity to the data network (see Ala-Laurila et al., col. 3, line 65-col. 4, line 23).

10. As per claim 15, Sawada-Ala-Laurila teach an address restriction method, wherein in a case where the determination step determines that the tentative network address is a network address out of the address range determined according to the predetermined rule, sending the message to the transmission source device forbidding the use of the obtained tentative network address (see Sawada et al., ¶ 215).

11. Claims 5, 9, 14, and 16 have similar limitations as to claims 1 and 15 above; therefore, they are being rejected under the same rationale.

12. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawada et al. and Ala-Laurila et al. as applied to claim 1 above, and further in view of Massarani (6,393,484).

13. As per claim 2, Sawada et al. and Ala-Laurila et al. teach the mentioned limitations of claim 1 above but fail to teach an address restriction method, wherein said determining step determines whether the obtained tentative network address includes predetermined data. However, Massarani teaches an address restriction method, wherein said determining step determines whether the obtained tentative network address includes predetermined data (col. 7, lines 10-23). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Sawada et al. and Ala-Laurila et al. to an address restriction method, wherein said determining step determines whether the obtained tentative network address includes predetermined

data in order to prevent unauthorized devices and users from obtaining network services in a dynamic user address environment (see Massarani, col. 3, lines 16-18).

14. As per claim 3, the above-mentioned motivation of claim 2 applies fully in order to combine Sawada et al., Ala-Laurila et al. and Massarani. Sawada et al., Ala-Laurila et al. and Massarani teach an address restriction method, wherein said obtaining step obtains a MAC address of a network interface provided for the transmission source device, as the local address unique to the transmission source device (see Massarani, col. 5, lines 26-54).

15. Claims 6-7 and 10-11 have similar limitations as to claims 2-3 above; therefore, they are being rejected under the same rationale.

16. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sawada et al. and Ala-Laurila et al. as applied to claim 1 above, and further in view of French et al. (2003/0041167). Sawada et al. and Ala-Laurila et al. teach the mentioned limitations of claim 1 above but fail to teach an address restriction method, wherein said sending step sends a message indicating that the tentative network address has a collision. However, French et al. teaches an address restriction method, wherein said sending step sends a message indicating that the tentative network address has a collision (see French et al., ¶ 235). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Sawada et al. and Ala-Laurila et al. to an address restriction method, wherein said sending step sends a message indicating that the

tentative network address has a collision in order to provide security at logical boundaries between networks (see French et al., abstract).

17. Claims 8 and 12 have similar limitations as to claim 4 above; therefore, they are being rejected under the same rationale.

18. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sawada et al. and Ala-Laurila et al. as applied to claim 9 above, and further in view of Okano et al. (2002/0062485). Sawada et al. and Ala-Laurila et al. teach the mentioned limitations of claim 9 above but fail to teach an address restriction apparatus, wherein said determination means performs a first determination of whether the obtained tentative network address has been generated from the obtained local address unique to the transmission source device and a second determination of whether the obtained tentative network address matches an address of the connection means; and said connection means sends the message forbidding the use of the obtained tentative network address according to the result of the first determination and the result of the second determination. However, Okano et al. teaches an address restriction apparatus, wherein said determination means performs a first determination of whether the obtained tentative network address has been generated from the obtained local address unique to the transmission source device and a second determination of whether the obtained tentative network address matches an address of the connection means; and said connection means sends the message forbidding the use of the obtained tentative network address according to the result of the first determination and the result of the

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second determination (see Okano et al., ¶ 197). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Sawada et al. and Ala-Laurila et al. to an address restriction apparatus, wherein said determination means performs a first determination of whether the obtained tentative network address has been generated from the obtained local address unique to the transmission source device and a second determination of whether the obtained tentative network address matches an address of the connection means; and said connection means sends the message forbidding the use of the obtained tentative network address according to the result of the first determination and the result of the second determination in order to enable a cable modem system utilizing a DHCP (Dynamic Host Configuration Protocol) to dynamically allocate an IP address to a subscriber terminal (see Okano et al., ¶ 2).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ranodhi Serrao whose telephone number is (571)272-7967. The examiner can normally be reached on 8:00-4:30pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571)272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/R. N. S./

Examiner, Art Unit 2141

6/25/2008

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2144